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Briefing

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EPC 2000 – Amendments to European Patent Law

On 13 December 2007, EPC 2000 will come into force amending the European Patent Convention (EPC), the legislation governing the European patent system.

Some notable changes are outlined below:

Central Limitation Procedure for European Patents – A patent proprietor may request amendments to limit the scope of a European patent at any time after grant in a single centralised procedure before the EPO that will be effective for all states. This is a major change in European practice and one that promises to be very useful to patent proprietors.

Doctrine of Equivalent – In interpreting a European patent, any element which is equivalent to an element specified in the claims is now to be given “due account”. The consequence of this amendment will only become clear on judicial interpretation. However, as an equivalent is not defined and file-history-estoppel was ruled out, the effect of this change is not expected to be substantial. The change is retroactive, applying to all granted European patents.

Second Medical Use of Compositions – Claims of the form “Compound or composition X for use in the treatment of disease Y” will now be considered novel in instances where the use was not previously known. It will no longer be necessary to formulate such claims in the so called “Swiss-form”. However, the ban on patenting methods of medical treatment remains.

Submission of Prior Art – New provisions enable the EPO to request details of prior art cited on equivalent applications. It is not yet clear how this provision will be implemented but applicants may be requested to submit references to “relevant” art cited in other jurisdictions.

Prior Art Effect of Co-pending European Applications – Once published, all European patent applications will be prior art that is citable against later filed European applications for the purposes of assessing novelty. Overlapping designated states are no longer necessary for the earlier application to be relevant.

Restriction on Additional Searches for PCT Applications – Once an International application has entered the European regional phase, the ability for the applicant to request further searches has been curbed. In order to have multiple inventions searched it will now be necessary to file a divisional application.

Relaxed Filing Requirements – Implementation of the Patent Law Treaty has relaxed the filing requirements before the EPO. A filing date can be obtained by filing a reference to a previously filed foreign application and/or by filing in any language, although a translation into an EPC official language is required subsequently. The requirements for claiming priority have been relaxed allowing late claims to priority and, in exceptional circumstances, the re-establishment of a priority right within 14-months of the priority date.

Reduced requirement for translations of priority documents – A translation of a priority document in a language that is not an official language of the EPC will in future be required only on the invitation of the EPO, in cases where the validity of the priority claimed is relevant to the assessment of patentability.

Miscellaneous Administrative Provisions – A multitude of administrative changes have been introduced by EPC 2000. In particular the “further processing” procedure now applies to more instances where there has been a loss of rights and is now the standard remedy following formal failures, although there remain a few deadlines in respect of which there is no remedy as of right. These administrative changes will affect procedure before the EPO and in some instances add complications that did not arise previously.

Norway joins the EPC

Norway has acceded to the European Patent Convention and the EPC will enter into force for that country on 1 January 2008. Norway can be designated in a European patent application filed on or after that date and, in an International (PCT) application, can be included in the list of states for which a European patent is sought. It is not possible to designate Norway retroactively in applications filed before 1 January 2008.

Norway's accession to the EPC brings the number of Contracting States to thirty-three, comprising all of the EU countries plus Switzerland, Liechtenstein, Turkey, Monaco, Iceland and Norway.

Reduced translation costs in sight

Following the long-awaited acceptance by France, the London Agreement on the application of Art. 65 EPC is now expected to enter into force in early 2008. The effect of the London Agreement will be to reduce post-grant translation costs which will make it easier to obtain a European patent - especially for small and medium-sized firms. The Agreement had previously been ratified by the required number of the EPC states, but failure of France to ratify had been an obstacle to its implementation. Ratification is still outstanding from a number of states where in principle there will continue to be a requirement for full translation where the European Patent is granted in a language that is not an official language of the state concerned. It is not compulsory for EPC states to become party to the London Agreement, and a number of states including Italy and Spain will not do so.

Further details of implementation, including the effective date, will become known in the next few months.

If you have any questions regarding any of the above changes, any other aspects of European patent law and EPC 2000 or require further information regarding the new provisions, please do not hesitate to contact your usual contact at Abel & Imray or email us at ai@patentable.co.uk with "EPC Changes" in the subject line.

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